

### **REMARKS**

Claims 35-48 have been added. Claim 19 has been amended. Claims 12-48 are now pending. No new matter has been added. Entry of the amendment is respectfully requested. Reconsideration is respectfully requested.

In Applicants' Response dated May 11, 2004, claims 1-11 were canceled without prejudice to place the Application in condition for allowance. At that time, the Examiner had indicated that the remaining claims 12-34 were allowable.

In the Action mailed June 25, 2004, the Examiner has rescinded his indication that claims 12-34 are allowable. As the Application was not allowed by the Examiner, Applicants have added new claims 35-45 which generally correspond to the canceled claims 1-11.

Previously, claims 1-10 were rejected under 35 U.S.C. § 101 because the claimed invention was asserted to be directed to non-statutory subject matter. Applicants continue to traverse this rejection. Nevertheless to further prosecution of the case, new claims 35-45 specifically recite that the method steps are performed through operation of at least one processor. Applicants continue to reserve the right to file Divisional applications including the original forms of the canceled claims 1-10.

### **Subject Matter Indicated To Be Allowable**

It was indicated in the Action that claims 19 and 20 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form. Claim 19 has been rewritten in independent form and includes all the material limitations of the original

base claims. Claim 20 depends from claim 19. It is respectfully submitted that pending claims 18 and 19 are allowable.

**The Pending Claims Are Not Obvious in View of the Applied Art**

Claims 12-18 and 21-34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ward, U.S. Patent No. 4,636,947 in view of Lawlor, et al., U.S. Patent No. 5,220,501 (“Lawlor”).

These rejections are respectfully traversed.

**The Applied References Do Not Disclose or Suggest the Features and Relationships Recited in Applicants’ Claims**

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Applicants are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or

motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The evidence of record must teach or suggest the recited features. An assertion of basic knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

It is respectfully submitted that the Action does not meet these burdens.

### **The Pending Claims Are Not Obvious Over Ward in view of Lawlor**

In the Action claims 12-18 and 21-34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ward in view of Lawlor. These rejections are respectfully traversed.

Applicants response to these rejections is based on the Office's referenced interpretation of Ward and Lawlor. Thus, any change in the Office's interpretation of Ward and Lawlor shall constitute a new ground of rejection.

Applicants traverse these rejections on the grounds neither Ward nor Lawlor alone or in combination disclose or suggest the features, relationships, and steps that are specifically recited in the claims. Nor is there any teaching, suggestion, or motivation cited for combining features of the cited references so as to produce Applicants' invention.

### **Claim 12**

Claim 12 is an independent claim directed to a method that includes performing a first transaction with an automated banking machine through operation of a transaction function device.

Ward shows an ATM task scheduling system for simultaneous peripheral device transaction processing. In Ward a transaction sequence table (Table 1; Column 12, lines 37-63) is shown which describes a sequence of events that can occur during a transaction. The order of the table can be modified to maximize the amount of parallel activity performed by individual peripheral subsystem controllers. For example as shown in Figure 6, Ward is operative to perform in parallel: printer header (214); get card data (212); and request pin (216) operations.

The Action asserts that Ward discloses "automated banking machine operating rules". However, the Action does not specify which portions of Ward corresponds to "automated banking machine operating rules". Thus Applicants have been forced to speculate that the Action has based its rejections on the transaction sequence table of Ward corresponding to automated banking machine operating rules.

The Action admits that Ward does not explicitly disclose steps (b) and (c) of claim 12 of: "(b) selecting through operation of the at least one processor a first transaction function device responsive to a first rule; and (c) performing the first transaction function with the automated banking machine through operation of the first transaction function device responsive to the selection". However, the Action asserts that Lawlor shows steps (b) and (c) in Figure 10 and that it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Ward method with the Lawlor method in order to promote customer satisfaction with the system by completing the transaction.

Applicants disagree. The asserted motivation to combine Ward with Lawlor is not present in either Ward or Lawlor. Nowhere does Ward or Lawlor suggest that the ATM of Ward is not capable of completing a transaction. Thus there is no motivation to one skilled in the art to look to Lawlor for the purpose of modifying Ward to be able to complete a transaction.

In addition, Figure 10 of Lawlor shows a flow chart with different branches a program may take depending on the answers to certain questions such as "DOES HOUSE HAVE MULTIPLE USERS?". Although such a flow chart may arguably correspond to programming rules, Lawlor does not disclose or suggest selecting a first transaction function device of an automated banking machine responsive to the flow chart shown in Figure 10. Therefore, the Action has failed to show where in Lawlor step (b) of claim 12 is disclosed.

As the Action has admitted that step (b) is not shown in Ward, and as Figure 10 does not show step (b) of Claim 12, even if it were possible to combine the teachings of Ward and Lawlor (which it is not), such a combination would still not show each and every feature and step recited in claim 12. As a result, the Office has not met its burden of establishing *prima facie* obviousness, and the rejection of claim 12 is not proper.

In addition, even if the Office rescinds its admission that Ward does not explicitly disclose steps (b) and (c) of claim 12, the combination of Ward and Lawlor would still not disclose or suggest each any every feature, relationship and step recited in claim 12.

For example, with respect to step (a) neither the transaction sequence table of Ward nor any other portion of Ward or Lawlor corresponds to rules which correspond to at least one sequence for use of a plurality of transaction function devices in operative connection with the automated banking machine, each of which transaction function devices is capable of carrying out a first transaction function.

Further, Ward does not recognize a need for storing rules as recited in step (a). For example, as discussed in Applicants' Specification, the rules as recited in step (a) can be used by the automated banking machine to select a backup transaction function device to perform a transaction function when the primary transaction function device is not available. In Ward each

different transaction function device is devoted to a different type of transaction function (e.g., audit printer 104 and receipt printer 106). Ward does not disclose or suggest different transaction function devices which are each capable of performing a first transaction. For example, Ward does not disclose or suggest that the both the audit printer (104) and the receipt printer (106) are both operative to perform a common transaction function such as printing a receipt for a user. Nowhere does Ward disclose that the audit printer can also be used to print receipts for a user.

Although the transaction sequence table of Ward may be used to order parallel processing of peripheral devices, Ward does not disclose or suggest that its transaction sequence table corresponds to a sequence for use of a plurality of transaction function devices, "each of which transaction function devices is capable of carrying out a first transaction function". Further, no other portion of Ward nor Lawlor discloses or suggests rules which are usable to select a transaction function device from among a plurality of transaction function devices which are each capable of performing a first transaction function.

Ward is directed to speeding up a transaction by performing functions in parallel. Neither Ward nor Lawlor teaches or suggests a need to provide rules for selecting which one of two or more transaction function devices to perform a transaction function each is capable of performing.

As nothing in the cited art discloses or suggests the features and relationships that are specifically recited in the claim, and because there is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Applicants' invention, it is respectfully submitted that claim 12 is allowable for these reasons. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection should be withdrawn. It follows that claims 13-21 which depend from claim 12 are likewise allowable.

## **Claim 22**

Claim 22 is an independent claim. The Action asserts that Ward discloses "at least one rule that includes a hierarchy in operation of a plurality of transaction function devices".

However, the Action does not specify which portions of Ward correspond to the at least one rule recited in claim 22. Thus Applicants have been forced to speculate that the Action has based its rejections on the transaction sequence table of Ward corresponding to the at least one rule recited in claim 22.

The Action admits that Ward does not explicitly disclose steps (b) and (c) of claim 22 of: "b) operating the at least one processor to select a first of the plurality of transaction function devices responsive to the hierarchy; and c) operating the at least one processor to cause the first transaction function device to carry out the first transaction function responsive to the selection". However, the Action asserts that Lawlor shows steps (b) and (c) in Figure 10 and that it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Ward method with the Lawlor method in order to promote customer satisfaction with the system by completing the transaction.

Applicants disagree. As discussed previously with respect to claim 12, the asserted motivation to combine Ward with Lawlor is not present in either Ward or Lawlor. Nowhere does Ward or Lawlor suggest that the ATM of Ward is not capable of completing a transaction. Thus there is no motivation to one skilled in the art to look to Lawlor for the purpose of modifying Ward to be able to complete a transaction.

In addition, Figure 10 of Lawlor shows a flow chart with different branches a program may take depending on the answers to certain questions such as "DOES HOUSE HAVE

MULTIPLE USERS?". Although such a flow chart may arguably correspond to programming rules, Lawlor does not disclose or suggest operating the at least one processor to select a first of the plurality of transaction function devices responsive to the flow chart shown in Figure 10.

Therefore, the Action has failed to show where in Lawlor step (b) of claim 22 is disclosed.

As the Action has admitted that step (b) is not shown in Ward, and as Figure 10 does not show step (b) of Claim 22, even if it were possible to combine the teachings of Ward and Lawlor (which it is not), such a combination would still not show each and every feature and step recited in claim 22. As a result, the Office has not met its burden of establishing *prima facie* obviousness.

In addition, with respect to step (a) neither the transaction sequence table in Ward nor any other portion of Ward or Lawlor corresponds to a hierarchy in operation of a plurality of transaction function devices, each capable of carrying out a first transaction function in the automated banking machine. Further, with respect to steps (b) and (c) neither Ward nor Lawlor discloses or suggests operating the at least one processor to select a first of the plurality of transaction function devices responsive to the hierarchy, and operating the at least one processor to cause the first transaction function device to carry out the first transaction function responsive to the selection.

As nothing in the cited art discloses nor suggests the features and relationships that are specifically recited in the claim, and because there is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Applicants' invention, it is respectfully submitted that claim 22 is allowable for these reasons. Therefore, it is respectfully



submitted that the 35 U.S.C. § 103(a) rejection should be withdrawn. It follows that claims 23-34 which depend from claim 22 are likewise allowable.

### **New claims**

Support of new claims 35-48 is found in the Specification and original claims. None of the cited references alone or in combination discloses or suggests the features and relationships that are specifically recited in the new claim 35-48. These claims recite features, relationships and steps recited in the previously presented claims and are allowable for at least the same reasons. As nothing in the cited art discloses nor suggests the features and relationships that are specifically recited in the new claims, and because there is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Applicants' invention, it is respectfully submitted that the new claims are allowable for these reasons.

### **Claim 35**

New claim 35 is an independent method claim similar to claim 12 and is allowable for at least the same reasons as claim 12. In addition, neither Ward nor Lawlor discloses or suggests storing rules which correspond to at least one sequence for use of a plurality of transaction function devices, where the transaction function devices are each capable of carrying out a substantially equivalent first transaction function. Further neither Ward or Lawlor discloses or suggests selecting a first transaction function device responsive to at least one of the rules and performing the first transaction function with the first transaction function device. On this basis claim 35 is allowable as well as claims 36-44 which depend from claim 35.

### **Claims 46 and 47**

New claim 46 is an independent method claim and recites subject matter recited in allowable claim 19. New claim 47 is an independent method claim similar to claim 46 and recites selecting in steps (c) and (e) the first and second transaction function devices respectively, responsive to the at least one of the rules and the data specifying the at least one capability. Neither Ward nor Lawlor discloses or suggests each of the features, relationships and steps recited in claims 46 or 47. On this basis, claims 46 and 47 are allowable.

### **Claim 48**

New claim 48 is an independent method claim. As discussed previously, neither Ward nor Lawlor discloses or suggests step (a) of storing in at least one data store in an automated banking machine including a cash dispenser, through operation of at least one processor, a plurality of automated banking machine operating rules, wherein the rules correspond to at least one sequence for use of a plurality of transaction function devices in operative connection with the automated banking machine, each of which transaction function devices is capable of carrying out a first transaction function.

In addition, neither Ward nor Lawlor discloses or suggests step (b) of selecting through operation of the at least one processor a first transaction function device responsive to at least one of the rules. Further, nowhere in Ward or Lawlor is there disclosed or suggested step (c) of determining through operation of the at least one processor that the first transaction function device selected in (b) is not available to carry out the first transaction function through operation of the first transaction function device. Also, with respect to step (d) Ward and Lawlor do not

disclose or suggest responsive to the determination in (c), selecting through operation of the at least one processor a second transaction function device responsive to the at least one of the rules. Further, neither reference discloses step (e) of performing responsive to the selection in (d) the first transaction function with the automated banking machine through operation of the second transaction function device. On this basis, claim 48 is allowable as well.

#### **Additional Claim Fees**

Previously Applicants had paid the extra claim fees for 34 pending total claims. New claims 35-45 have been added which take the place of claims 1-11 previously canceled. Thus additional claim fees should not be due with the addition of new claims 35-45. However, claim fees are due for the amendments associated with rewriting claim 19 into independent form and with the addition of the three independent claims 46-48. Please charge the fees associated with prosecution of four additional independent claims in excess of three (\$344) and three additional total claims (\$54) and any other fee due, to Deposit Account No. 09-0428 of InterBold.

#### **Conclusion**

Each of Applicants' pending claims specifically recites features and relationships that are neither disclosed nor suggested in any of the applied art. Furthermore, the applied art is devoid of any such teaching, suggestion, or motivation for combining features of the applied art so as to produce Applicants' invention. Allowance of all of Applicants' pending claims is therefore respectfully requested.

The undersigned will be happy to discuss any aspect of the Application by telephone at the Examiner's convenience.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'R. E. Jocke', is written over a horizontal line.

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